

Patent 5,990,027 to Hendricks. Hendricks qualifies as prior art under 35 U.S.C. § 102(e) because its issue date of November 23, 1999 is after Applicant's filing date of December 21, 1998, and Applicant reserves the right to swear behind the reference at a later date. Nonetheless, Applicant respectfully disagrees with the Examiner's rejection of the claims over the combination of Lawler and Hendricks.

Lawler discloses a television program reminder for an interactive cable television system that allows a viewer to select a specific program from a program guide. A corresponding tag stored at the headend and is used to display a reminder to the user shortly before the program is to be broadcast. The Examiner admits that Lawler does not disclose storing program recording information local to the user as claimed by Applicant and relies on Hendricks to teach this missing element. As motivation for the combination, the Examiner states:

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler to store the reminder information locally as taught by Hendricks thereby allowing a user to view a reminder and watch a program *even if the network connection between the STB and the headend is severed*. [emphasis added]

However, as well known in the art, a connection between the STB (set top box) and the headend is required to watch or record a broadcast program in the television delivery systems taught by Lawler and Hendricks. Therefore, the Examiner's stated motivation for the combination is not supported by either of the references or the art as a whole and, in fact, runs counter to the accepted teachings of the art. Because the combination is improperly motivated, the Examiner has failed to state a *prima facie* case of obviousness for claims 1-7, 9, 10, 19-20, 23-34, 38, 40-42, 49-52 and 54-56, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(b) over the combination.

**Claims 8, 11-18, 21, 22, 25-37, 29, 43-48, 53 and 57-60**

Claims 8, 11-18, 21, 22, 25-37, 29, 43-48, 53 and 57-60 were rejected under 35 U.S.C. § 103(a) as being obvious over Lawler in view of Hendricks and U.S. Patent 5,583,560 to Florin. As argued above, the combination of Lawler and Hendricks is improperly motivated and cannot form the basis for a proper *prima facie* case of obviousness. Furthermore, Applicant respectfully submits that the combination of

Lawler, Hendricks and Florin cannot render Applicant's invention obvious because the does not teach each and every element of the invention as claimed in claims 8, 11-18, 21, 22, 25-37, 29, 43-48, 53 and 57-60.

Florin discloses a system that displays an icon on broadcast advertisements that can be activated by a remote control to show the viewer more information about the advertised products. The Examiner is relying on Florin to teach Applicant's claimed element of issuing a notification to a viewer during an advertisement for an upcoming program to determine if the viewer is interested in the program. However, Applicant further claims that the viewer's response to this notification generates a signal that causes the program reminder to be shown to the viewer. No teaching in Lawler, Hendricks or Florin suggests modifying Florin's icon to create such a signal and doing so would render Florin's invention inoperable for its intended purpose.

Therefore, the combination of Lawler, Hendricks and Florin do not teach each and every element of Applicant's invention as claimed in claims 8, 11-18, 21, 22, 25-37, 29, 43-48, 53 and 57-60 and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(b) over the combination.

### **SUMMARY**

In this response, no claims have been canceled, amended, or added. Therefore, claims 1-60 are currently pending. In view of the foregoing remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-3476.

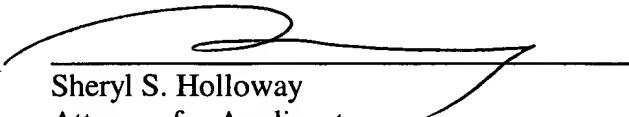
**Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

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